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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/508,490 03/10/00 BODE

R 20496-248

IM22/1018

EXAMINER

PROSKAUER ROSE  
1585 BROADWAY  
NEW YORK NY 10036

COMBS, J

ART UNIT

PAPER NUMBER

1742

*6*

DATE MAILED:

10/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/508,490	BODE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Janelle Combs-Morillo	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.--  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 16 July 2001.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 3-5 is/are rejected.

7) Claim(s) 2 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 7 recites the phrase "stored to storage temperature", the examiner suggests changing "to" to --at-- in order to clarify. Claim ~~7~~ line 11 recites the step "to storage the cold strip is cold worked", which renders the claim indefinite. Clarification is needed. The examiner points out that method claims must have actively recited steps (i.e. rolling, working, storing).

Claims dependent on the above rejected claims are likewise rejected under this statute. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson.

Stevenson teaches a process for making a steel strip from ageing sensitive steel with improved formability (column 7 line 10) comprising the steps of: hot or cold rolling (including temper rolling) (column 3 lines 40-41, 45), cooling to a temperature below room temperature (abstract), and forming (abstract), as presently claimed in claim 1.

Stevenson does not specify a) a stove finish treatment of said formed steel strip or b) the difference in the upper and lower yield points  $R_{eh} - R_{el} < 2N/mm^2$  (independent claims 1 and 3). However, it is known in the art to stove finish steel strips, and therefore held to be within the disclosure of Stevenson. Concerning item b), the examiner asserts that because Stevenson teaches substantially the same method steps performed on substantially the same product as presently claimed, substantially the same results (such as difference in yield points) would occur.

Concerning claim 3, Stevenson also teaches that a steel strip can be retained at room temperature for about a week prior to forming (column 4 lines 35-42).

Concerning claims 4 and 5, Stevenson does not teach the bake hardenability of the steel strip that has been processed according to the present invention. However, the examiner asserts that because Stevenson teaches substantially the same method as presently claimed, substantially the same results (such as bake hardening) would occur.

It is held that Stevenson has created a *prima facie* case of obviousness of the presently claimed invention.

5. Claim 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaoka et al.

Nakaoka et al teaches a process for producing a steel sheet from aging sensitive steel (page 1 lines 33-41) with high formability at the forming stage, exhibiting recovery of the yield

point elongation after accelerated aged as low as 0.2% (column 6 lines 13-15), high bake hardening potential (column 6 lines 12-13), and wherein said steel "shows excellent nonaging property in spite of a great amount of soluted [N] content" (column 2 lines 67-68). Said steel is produced by a process comprising the steps of holding the steel strip at room temperature (column 8 line 27, column 12 line 17), temper rolling, forming (column 2 lines 10-12, 58-62), and coat baking, as presently claimed in independent claim 3.

Nakaoka et al does not specify a) that the forming step involves cold working, or b) the difference in the upper and lower yield points  $R_{eh}-R_{el} < 2N/mm^2$  (independent claims 1 and 3). However, it is known in the art to form ageing sensitive steel by a variety of operations, including cold forming. Given the disclosure of Nakaoka, it would have been obvious to one of ordinary skill in the art to form the steel sheet by cold forming. Concerning item b), the examiner asserts that because Nakaoka teaches substantially the same method as presently claimed, substantially the same results (such as difference in yield points) would occur.

Concerning claim 5, Nakaoka teaches the bake hardenability is  $\sim 11.1 \text{ kg/mm}^2$  (109  $\text{N/mm}^2$ ), which falls within the presently claimed range (column 6 lines 12-13).

Because Nakoaka et al teaches substantially the same process as presently claimed, as well as a bake hardenability within the presently claimed range, Nakaoka et al is held to create a *prima facie* case of obviousness of the presently claimed invention.

#### *Response to Amendment/Arguments*

6. In the amendment filed on July 16, 2001, applicant amended claims 1 and 3 and added new claims 4 and 5. The amendment filed September 29, 1999 has been entered/considered. The

112 second paragraph rejections have not all been overcome, as stated above. In view of applicant's arguments and submission of definitions of the phrases "stove finished" and "dressed strip", the use of these terms is deemed proper. The argument that Stevenson does not disclose or suggest the maximum value for the condition  $R_{ch}-R_{cl}$  has not been found persuasive (see above). Because the presently stated method claims overlap the steps taught by the prior art, and because applicant has not clearly shown unexpected results with regard to the prior art of record, the rejection is deemed proper. The argument that Nakoaka does not teach ageing sensitive steel has not been found persuasive. Nakoaka teaches steel that "shows excellent nonaging property in spite of a great amount of soluted [N] content" (column 2 lines 67-68), that is, ageing sensitive steel that shows nonaging properties.

#### *Allowable Subject Matter*

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Because claim 1 requires a storage temperature below room temperature, and because Stevenson does not teach or suggest storage times according to equation 3 (i.e. storage times  $\geq$  28 hours), the presently stated claim is allowable over the prior art of record.

#### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (703) 308-4757. The examiner can normally be reached on 7:30 am- 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7719 for regular communications and (703) 305-7719 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jcm *JM*  
October 12, 2001

ROY KING  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700